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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/608,744

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Roger S. Salmonson

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EXAMINER

FLOOD, MICHELE C

ART UNIT

PAPER NUMBER

1655

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/608,744

Applicant(s)

SALMONSON, ROGER S.

Examiner

Michele Flood

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

This application contains claims 1-8 drawn to an invention nonelected with traverse on December 20, 2004. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

The text of those sections of Title 35 U.S. Code not included in this action can be found in a prior Office action.

Claims 9 and 10 are under examination.

Response to Arguments

Claim Rejections - 35 USC § 103

Claims 9 and 10 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrov-Egorov et al. (P) in view of Yokoyama (N), Leontev et al. (Q), Karita et al. (O, translation of foreign patent provided herein) and Pike (*B), and further in view of Zobitne et al. (*A) and Lawless (U). The rejection stands for the reasons set forth in the previous office action and set forth below.

Applicant's arguments have been fully considered but they are not deemed persuasive because the cited references provide the suggestions and motivation to the claimed invention.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that

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any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the primary reference of Bobrov-Egorov was relied upon because Bobrov-Egorov taught a composition comprising the following ingredients (wt.%): (i) an aromatising component (0.5-20.0) comprising essential oil derived from mint, fir, coriander, anise, camphor, dill, cloves or fennel and containing a toning preparation (not more than 0.2% of base weight) comprising vanilla and/or oil extracted from filbert, chestnut, pine kernels, walnut, sea buckthorn and/or dog rose; oil extracts from everlastings, Leonorus, yarrow, celandine, thyme, Origanum, St. John's wort, peppermint, sage, dog rose fruit, coriander, caraway, horse chestnut, pine buds and calendula blossom (balance). Bobrov-Egorov further taught that the referenced composition has analgesic activity;

and, is useful in medicine, particularly gynecology. With regard to the primary reference of Bobrov-Egorov, Applicant argues that Bobrov-Egorov does not teach the first four components of the instantly claimed invention, and that Bobrov-Egorov does not teach menthyl acetate, alpha pinene or beta pinene, and particularly camphor white oil.

Therefore, because Bobrov-Egorov taught the instantly claimed invention except for cornmint oil (although it is not clear as whether the mint oil taught by Bobrov-Egorov is not cornmint oil), orange oil, pennyroyal oil, and rosemary Spanish oil, the secondary references of Yokoyama, Leontev, Karita and Pike were relied upon because each taught that the claim-designated essential oils were known in the art beneficial analgesic functional effects. For instance, Yokoyama taught a composition comprising an essential oil of *Mentha arvensis* an analgesic agent, which is also known in the art as cornmint, as evidenced by the teachings of Zobitne. Note that Zobitne taught that cornmint oil includes a high concentration of alpha-pinene and beta-pinene, in Column 2, lines 5-13. Further note that Lawless taught that cornmint oil comprises menthyl acetate, on page 174. Nonetheless, Applicant argues that Yokoyama fails to teach cornmint. Instead, Applicant argues that Yokoyama teaches peppermint oil. However, as evidenced by the teachings of Zobitne and Lawless, the essential oil of *Mentha arvensis* is not one and the same as the essential oil of cornmint, even though Zobitne expressly teaches evidence to the contrary in Column 3, lines 8-15. While Applicant argues that the teachings of Zobitne is non-analogous art, please note that the Office relied upon the referenced patent merely to establish that the cornmint oil is derived from the *Mentha arvensis* plant and that cornmint oil comprises alpha-pinene and beta-

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pinene. Clearly, Yokoyama teaches cornmint oil, although Yokayama refers to the essential oil of the referenced plant as an essential oil of peppermint. Similarly, the teachings of Lawless were relied upon to provide evidence that the leaves of the *Mentha arvensis* plant comprise menthyl acetate. Secondly, Leontev taught a composition having anesthetic activity comprising effective amounts of a Component (I) comprising camphor and mint oil; and, a Component (II) of any of the following oils: coriander, orange, rose, peppermint, calendula, etc. With regard to the teachings of Leontev, Applicant argues that the referenced composition is prepared by mixing camphor with the referenced essential oils, and that combining the secondary reference is impermissible hindsight. However, as the primary reference clearly teaches a composition comprising a camphor oil having analgesic activity and with Leontev teaching compositions comprising a camphor source in combination with the claim-designated essential oil ingredients having analgesic activity, the Office maintains it would have been obvious to substitute one camphor source for the other in the making of the claimed invention, absent evidence to the contrary that the composition taught by Bobrov-Egorov is not a white camphor essential oil. Next Applicant argues that each of the teachings of Karita and Pike combined with the teachings of Bobrov-Egorov is impermissible hindsight. However, Applicant's argument is not persuasive because thirdly, Karita taught an analgesic oil composition comprising at least one kind of essential oil selected from a group consisting of orange oil, grapefruit oil, mandarin oil and lemon oil, at least one kind of essential oil selected from a group consisting of lavender oil, lavandin oil and rosemary oil and at least one kind of essential oil selected

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from a group consisting of eucalyptus oil, chamomile oil, Taiwan hinoki and mugwort oil. In [0023], Karita also taught that pennyroyal oil (*Mentha pulegium*), *Mentha arvensis* oil (cornmint oil) and rosemary oil (also known in the art as rosemary Spanish oil or *Rosmarinus officinalis*) are useful in the making of the referenced analgesic composition. Furthermore, Pike taught a composition for alleviating cramps, aches and pains, such as those associated with premenstrual syndrome, comprising pennyroyal oil.

Thus, with Bobrov-Egorov providing the motivation of using a composition comprising effective amounts of an essential oil derived from mint, fir, coriander, anise, camphor, dill, cloves or fennel and effective amounts of vanilla and/or oil extracted from filbert, chestnut, pine kernels, walnut, sea buckthorn and/or dog rose; oil extracts from everlastings, Leonorus, yarrow, celandine, thyme, Origanum, St. John's wort, peppermint, sage, dog rose fruit, coriander, caraway, horse chestnut, pine buds and calendula blossom (balance), which has analgesic activity and is useful in gynecology; and, with Yokoyama teaching cornmint oil or the essential oil of *Mentha arvensis* as an analgesic agent; and, with Leontev teaching a composition having anesthetic activity comprising effective amounts of a Component (I) comprising camphor and mint oil; and, a Component (II) of any of the following oils: coriander, orange, rose, peppermint, calendula, etc.; and, with Karita teaching that any of the essential oils selected from a group consisting of orange oil, grapefruit oil, mandarin oil and lemon oil, and at least one kind of essential oil selected from a group consisting of lavender oil, lavandin oil and rosemary oil and at least one kind of essential oil selected from a group consisting

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of eucalyptus oil, chamomile oil, Taiwan hinoki and mugwort oil, as well as, pennyroyal oil , cornmint oil) and rosemary oil are useful in the making of a composition having analgesic activity; and, with Pike teaching composition for alleviating cramps, aches and pains, such as those associated with premenstrual syndrome, comprising pennyroyal oil, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the instantly claimed old and well-known ingredients to provide a composition for the use as a composition to reduce pain associated with menstruation, such as pain, as suggested by the cited references. As each of the references clearly indicate that the various proportions and amounts of the ingredients used in the claimed composition are result variables, they would have been routinely optimized by one of ordinary skill in the art in practicing the invention disclosed by that reference. Therefore, the invention as a whole was clearly *prima facie* obvious in the absence to the contrary.

No claims are allowed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

* Applicant is advised that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources. Should you receive inquiries about the use of the Office's PAIR system, applicants may be referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Flood whose telephone number is 571-272-0964. The examiner can normally be reached on 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on 571-272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


MICHELE FLOOD
PRIMARY EXAMINER

Michele Flood
Primary Examiner
Art Unit 1655

MCF
October 17, 2005